

In the drawings:

Please enter the attached Replacement Sheet (Figs. 1, 2, 5, and 6) and New Sheet (Fig. 7), of drawings.

REMARKS

Introduction

Reconsideration, withdrawal of the restriction requirement, and allowance of the application based on the foregoing amendments and for other reasons, are respectfully requested.

Claims 1-20 are pending in the application. Claims 18-20 stand withdrawn from consideration by the Examiner following a restriction requirement and an election. Claims 1-17 stand rejected.

Applicant takes up the Examiner's concerns in the same order that they appear in the DETAILED ACTION section.

Election/Restrictions

The Examiner required restriction of the claims to one invention - either that of product claims 1-17 or that of "process of use" claims 18-20. Applicant, via a telephone interview, elected the product claims invention, with traverse.

Applicant traverses on the basis that to be properly restrictable, different sets of claims in an application must be for independent and distinct inventions. Applicant urges that the product and process claims in the instant case are related, and should not be divided. As was said in *Ex parte Dye and Maldock*, 75 USPQ 167 (1946), "... where an inventor has made a distinctly inventive advance in the art, it is not the practice of this Board to restrict him to a single form of claim, i.e., either to the process or apparatus where there is no clear line of division between them". Applicant has made a distinctly inventive advance (simple child sling) in the art. She should be permitted to claim it by both apparatus and method claims.

Applicant urges that the inventions are not "independent" and "distinct". An "independent invention is one for which there is no disclosed relationship between it and the other invention . In other words, the two inventions are unconnected in design, operation, or effect. A process and an apparatus incapable of being used in practicing the process would be independent of each other. That is not the case here: a relationship is disclosed. The apparatus can be used in practicing the process. The process can be used to make the apparatus. Thus the process and the product are "related" and not "independent".

The "related" inventions (process and product here) are also "not distinct". The process and the product made using the process are not known to be capable of separate manufacture,

use, or sale. The product structures called for by the claims result from the employment of the process steps. The achievement of the product structures require the performance of the process steps, which as *Ex parte Dye and Maldock*, supra, holds, applicant is entitled to. One basic invention obtains; the claims merely provide different looks of the invention!

Applicant urges that the process claims are not for a process of use of the product, but rather for a process of making the product. For example, claim 18 defines the process for making the product of claim 9. Thus the process cannot be used to make a materially different product. Furthermore, the product as claimed cannot be made by a materially different process. Thus product claimed and the claimed process for its manufacture, are not distinct. Since they are not distinct, restriction is improper. MPEP 806.05.

Information Disclosure Statement

The Examiner noted that "the listing of references in the specification is not a proper information disclosure statement." Also that "unless the references have been cited by the examiner on form PTO-892, they have not been considered". In the Specification, under "3. Prior Art", applicant identified the Didymos sling. Applicant considers the Examiner's citation of the Didymos-Erika-Hoffmann European Patent Application "EP 0 792 605 A1" as obviating the need for an Information Disclosure Statement.

Drawings

The drawings were objected to because "one of ordinary skill in the art cannot determine how the sling is mounted over the users shoulder". Applicant urges otherwise in view of statements such as those appearing on lines 26 to 28 of page 4 of the Specification:

"The child's sling of the invention would be mounted by the carrier by looping the sling 10 over the carrier's back and so the channel 12 was the lower portion and waist high."

Nevertheless, applicant is complying with the Examiner's recommendation for "More enabling drawings, perhaps a step-by-step sequence for mounting the child sling on a person". Thus applicant has attached a New Sheet of drawing bearing a Fig. 7 showing a twelve-step sequence for mounting the child's sling in the Cross-Carry position. The sequence tracks the description appearing in the penultimate paragraph on page 4 of the Specification and the

following paragraph on pages 4 and 5, and with which it is fully integrated. Fig. 7, with its sequence descriptions, also has been integrated into the BRIEF DESCRIPTION OF THE DRAWINGS OF A PREFERRED EMBODIMENT OF THE INVENTION section on page 3 of the Specification.

The Examiner is correct in his assumption that "double shoulder carrying position" is meant to be the "cross-carrying position". However, this issue is deemed to have been rendered moot by the removal of the "labeling of the views as front, back, and the different positions" the Examiner deemed "should not be shown". Hence, the drawings are only labeled as Fig. 1, Fig. 2, Fig. 5, and Fig. 6 on the one Replacement Sheet attached. (The second drawing sheet, Figs. 3 and 4, bore no labels.)

Specification

The disclosure was objected to because "it contains an embedded hyperlink and/or other form of browser-executable code". Applicant has deleted the embedded hyperlink and/or other form of browser-executable code by providing above two (2) replacement paragraphs for paragraphs on page 1 and on pages 1 and 2 of the Specification.

Claim Rejections - 35 USC 112

Claims 8-14 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement, the Examiner alleging that the "claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Based on both the claimed steps and the disclosed steps for mounting the child sling onto a person, it is unclear how the 'cross-carrying position' of figures 1 and 2 is obtained. Applicant never states that any portion of the sling is passed over a user's shoulder(s) as shown in figures 1 and 2."

Applicant invites the Examiner's attention to lines 26 to 28 of page 4 of the Specification which read in part:

"The child's sling of the invention would be mounted by the carrier by looping the sling 10 over the carrier's back and so the channel 12 was the lower portion and waist high.

Thereafter the two branches 14 and 16 are crossed in front of the carrier's waist, the longer branch 16 being inside the other and being passed behind the carrier and through the channel 12 in back;"

Applicant urges that the application thus states that a "portion of the sling is passed over a user's shoulder(s) as shown in figures 1 and 2". Particularly is this true when considered with the recital in claim 8 that "a first branch of the sling is passed across the front of the would-be carrier and around the back ---".

Hence applicant submits that the claim(s) contains subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Based on both the claimed steps and the disclosed steps for mounting the child sling onto a person, it is clear how the 'cross-carrying position' of figures 1 and 2 is obtained. Applicant does state that a portion of the sling is passed over a user's shoulder(s) as shown in figures 1 and 2.

Applicant furthermore wishes to note that base claim 7 on which claims 8-14 are dependent, directly or indirectly, specified that "an elongated piece of fabric having a channel disposed between its ends" that would "be in the middle of the would-be-carrier's lower back when the sling is looped over the carrier's head". Thus claim 7 too states how a portion of the sling is passed over a user's shoulder(s) as shown in figures 1 and 2. Claim 8, a directly dependent claim, amplifies this by specifying that "a first branch of the sling is passed across the front of the would-be carrier and around the back through the channel and to the front of the would-be-carrier". Hence it should also be clear how the "cross-carrying position of figures 1 and 2 is obtained.

Claims 8-14, 16, and 17 were rejected 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, the Examiner saying it "is unclear whether applicant is claiming the child sling or the method by which the sling is mounted on the user". Applicant was endeavoring to claim the child sling as it is structured on a child carrier. To make this more clear, applicant has

amended the claims to emphasize the structural components. For example, in claim 8 "is passed" has been replaced by "passes" so that the claim reads in part "the sling passes across the front of the would-be carrier and around the back through the channel and to the front of the would-be-carrier when in use".

Claim Rejections - 35 USC 102

Claims 1-17 were rejected under 35 USC 102(b) as being anticipated by Hathaway (4,139,131), the Examiner alleging that "Hathaway discloses a child's sling having a channel (40) between its ends (figure 7), wherein; the sling is an elongated piece of fabric (col.2 line 15); the channel is near the middle of the sling (figure 3); the channel extends over the entire width of, or cross-wise, the sling; a pocket is formed (col. 4 line 20); either the left or right branch of strap (70) can be passed through the channel, one on top of the other (figure 7); each branch can be tied in a knot (104) with the other (figure 14); and a pocket (37) is formed in a branch of the strap (col. 4 line 32) that is not used to form, and is thus beyond, the knot (figure 14)." Applicant begs to differ!

Hathaway's sling does not have a channel (40) between its ends (figure 7). Hathaway's carrier does have a loop 40, but it is secured to the bottom of the padded-seat body 22 (col. 3 lines 67 and 68).

Nor does the Hathaway's sling have a pocket, let alone a pocket for holding child-care things. Hathaway' pocket P is for receiving and supporting the child itself, and is not formed in his suspension strap 70.

Thus Hathaway clearly does not anticipate applicant's claimed device. And he shouldn't, for his device clearly is a different and more complex structure.

To make this difference more clear, applicant has amended the claims to more specifically define applicant's unique structure. As noted above, Hathaway's strap 70 is a suspension strap for his child support body 22. Conversely, the child is supported in applicant's device directly in the sling itself: no support body is needed

Claims 1-17 as amended specify that the sling is the sole child support. For example, claim 1 now reads in part: "A child's support consisting of a sling having ---". Thus the claims now specify a child's support consisting of a sling. This means that "the claim requires devices [child's support] having the recited elements [sling], and no more, ---". (See the

second paragraph of Section 8 "Consisting", page II-9 of the treatise "Landis on Mechanics of Patent Claim Drafting", by Robert C. Faber, Practising Law Institute, Fourth Edition, Copyright 1996; and cited cases.) The Hathaway child support includes not only his suspension strap 70, but also his body 22. Hathaway does not anticipate applicant's device, and applicant's claims recite structural differences, and hence are not anticipated.

Claims 8-14, 16, and 17 were deemed by the Examiner "not to impose any patentably distinguishing structure over that disclosed by Hathaway" via "the initial statement of intended use and all other functional implications", the Examiner saying that Hathaway "is capable of being used in the intended manner, i.e. carrying a child in the cross-carrying position or the single-shoulder carrying position" and that there "is no structure in Hathaway that would prohibit such functional intended use (see MPEP 2111)". Applicant believes that there are at least three issues here: one being the patentable significance of functional-use limitations, the second being if the Hathaway device could be used in the claimed way, it can constitute prior art; and the third being whether Hathaway can be used in the claimed way.

Taking the issues up in reverse order, applicant urges that Hathaway can not be used in the claimed way. Hathaway's suspension strap 70 is secured to his body 22. Having the body 22 disposed in the back of the carrier would render the device impracticable to say the least: sitting becoming a near impossibility. Hathaway, it is believed, can not be used in the claimed way. Applicant therefore urges that the Examiner is in error when he states that there "is no structure in Hathaway that would prohibit such functional intended use".

Removing the body 22 would remove the loop 40, too. Hathaway would no longer be useful for its intended purpose. The destructive modification of one device to anticipate another was declared improper in *Ex Parte Johnson*, 17 USPQ 374 (1932): "Where modification of the structure shown by a reference to meet the claims of applicant's application would require reconstruction of the device by removing parts that are essential for the intended operation and by substituting others which were not contemplated, rejection of the claims on such a reference is not sound." Thus even if parts of Hathaway can be used in the claimed way, they can not constitute prior art.

Even if the whole of Hathaway can be used in the claimed way, Hathaway does not constitute prior art. To be prior art, the reference must teach what the applicant has invented: it

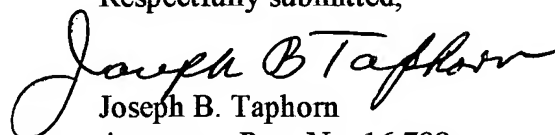
is not sufficient that it could be so used. See Johnson v. Tvedt, 244 F. 189, which held: "In order to constitute anticipation of a patented invention, it is not sufficient that the device relied upon might with some change be made to accomplish the function performed by that invention if it were not designed by its maker to accomplish it or actually used for its accomplishment." Hathaway was not designed by its maker to accomplish what applicant claims or actually used for her accomplishment.

The first issue, the patentable significance of functional use limitations, is deemed to have been rendered moot by applicant's amendment of the claims. Applicant has amended the claims to substitute clearly structural limitations. For example, in claim 8, "is passed" in line 2 has been replaced with "passes", and "when in use" added to the end of the claim to indicate when the structure obtains. Thus, patentably distinguishing structure over that disclosed by Hathaway, is recited in the claims.

Conclusions

Wherefore it is believed that it has been shown that the restriction requirement should be withdrawn, that an Information Disclosure Statement is not needed, that the drawing sheets have been corrected; that the Specification has been appropriately deleted; that the claims are not anticipated by Hathaway and that Hathaway does not disclose all aspects of the claimed invention; that the claims have been amended to distinguish more clearly over the art; and that this application has been placed in condition for allowance, which favorable action at an early date is earnestly solicited.

Respectfully submitted,



Joseph B. Taphorn

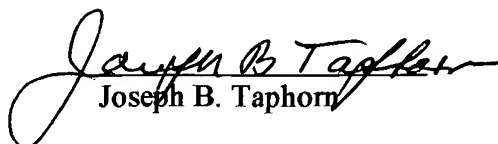
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Attachments

CERTIFICATE OF MAILING - The undersigned certifies that this correspondence addressed to the Commissioner for Patents, P.O. 1450, Alexandria, VA 22313-1450, has been deposited in the United States Postal System as first class mail with sufficient postage on December 1, 2005.



Joseph B. Taphorn